

**R E M A R K S**

Claims 1 - 58 are pending in the present application.

Claims 1, 21, 22, 24, 25, 34- 37, 45 - 48 and 52 - 58 are independent.

**A. Section 103(a) Rejections**

Claims 1 - 58 are rejected as being unpatentable over a combination of U.S. Patent No. 6,044,363 to Mori and U.S. Patent No. 6,151,589 to Aggarwal. We traverse the Examiner's Section 103(a) rejection.

**Wrong Standard Used**

According to page 3 of the Office Action, the obviousness rejection is based on an assertion that the combination of Mori and Aggarwal would "teach the disclosure". Also, the obviousness rejection only includes a description of Mori and Aggarwal. No reference is made to any of the limitations of any of the pending claims. Accordingly, we assume that the rejection is based on an assertion that a combination of Mori and Aggarwal would produce certain subject matter that exists in the present application.

Whether the prior art might teach some parts of the disclosure is irrelevant - the claims are the only part relevant to the obviousness determination. Accordingly, no *prima facie* showing of obviousness has been presented.

**The Claims distinguish over the cited References**

To expedite allowance, each independent claim is distinguished from the references cited. Specifically, certain limitations (rather than the entire claim) are described to demonstrate that the limitations are not disclosed by the cited references.

**Independent Claims 1, 21, 22, 24**

*at least one rule for controlling when a bid may be placed automatically for a bidder*

Mori discloses rules controlling bid prices and quantities, not when bids may be placed. Aggarwal specifies time between auctions, and has nothing to do with bids.

**Independent Claim 25, 34, 35, 36**

*receiving / accepting information about the auction  
matching / comparing the information about the auction to a behavior*

Neither Mori nor Aggarwal has anything to do with matching or comparing anything to a behavior, much less as claimed.

**Independent Claim 37, 45, 46, 47**

*receiving / accepting an indication of a selected auction behavior; and  
matching / comparing the auction behavior to a rule to encourage the auction behavior.*

Neither Mori nor Aggarwal has anything to do with encouraging any auction behavior, much less in the manner claimed.

**Independent Claim 48, 52, 53, 54**

*applying a rule associated with the bidder and having a condition specifying when to place a bid; and  
if the condition of the rule is satisfied, and if a highest bid in the auction is not from the bidder, and if a bid for the bidder may be accepted, placing / submitting the bid according to a specified bidding behavior*

Mori discloses rules controlling bid prices and quantities, not when bids may be placed. Aggarwal specifies time between auctions, and has nothing to do with bids.

**Independent Claim 55**

*receiving information indicating bidding information for an auction;  
determining at least one of an average time period between bids and an average increment between bids; and  
storing the determined information as an associated auction behavior.*

Neither Mori nor Aggarwal has anything to do with determining an average time period between bids or an average increment between bids.

**Independent Claim 56**

*determining a behavior of each of the concluded auctions from the bidding information:  
selecting the behavior of the auction having the best outcome as the beneficial auction behavior.*

Neither Mori nor Aggarwal has anything to do with determining a behavior of concluded auctions, much less selecting a behavior having the best outcome.

**Independent Claim 57**

*defining data associating each of one or more desired auction behaviors to one or more rules for controlling when a bid may be placed automatically for a bidder in an auction*

Neither Mori nor Aggarwal has anything to do with when a bid may be placed automatically.

**Independent Claim 58**

*defining data associating a maximum bid and a bidder with an indication of a rule for controlling when a bid may be placed automatically for a bidder in an auction.*

Neither Mori nor Aggarwal has anything to do with when a bid may be placed automatically.

**No motivation to Combine or Modify**

There is no motivation to combine Mori nor Aggarwal. The stated motivation:

"to teach an auction method to be utilized for dynamically adjusted time intervals"

would not in any way prompt one of ordinary skill in the art to seek out Mori, which merely teaches rules controlling bid prices and quantities, not auctions themselves.

In addition, there would be no benefit from combining the references. Mori discloses rules controlling bid prices and quantities, while Aggarwal deals with the time between auctions, but has nothing to do with bids.

**B. Section 101 Rejections**

Claims **24, 36, 47, 54 and 57 - 58** stand rejected as being non-statutory. We traverse the Examiner's Section 101 rejection.

The entirety of the Section 101 rejection is that the claims are rejected:

"for failing to define a concrete and tangible output. There is no functionality recited in these claims"

**Products Need Not Define an Output**

A product claim need not define any "output", much less "define a concrete and tangible output". For example, an article of manufacture such as a doorstop or paper clip would be statutory subject matter even though it would not "define" any "output".

**Products Need Not "Recite" Functionality**

Also, functionality need not be recited in a claim itself. In fact, it is not clear exactly what recitation in a claim would be a recitation of "functionality".

If instead the allegation is that the claimed products do not have any utility, this is incorrect. Claims **24, 36, 47 and 54** are each directed to a computer program product which includes a computer readable medium with computer program instructions stored thereon. The computer program instructions when executed by a computer, directs the computer to perform a method which is useful as described in the disclosure. Claims **57 and 58** are each directed to a digital information product which includes a computer-readable medium and information defining data stored thereon. The data likewise have a utility as described in the disclosure.

Accordingly, no *prima facie* showing of nonstatutory subject matter has been presented.

### C. Section 112 Rejections

Claims 1 - 58 stand rejected under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph as being indefinite. We traverse the Examiner's Section 112 rejection.

#### The Standard Used

The entirety of the indefiniteness rejection is the following sentence:

"The independent claims too broad and indefinite to enable one to distinguish the disclosure over the prior art."

The reasons why all claims are believed indefinite is not apparent from the rejection.

#### Breadth is not Indefiniteness

The rejection appears to be based on the breadth of the claims and a belief that the claims cannot "distinguish the disclosure over the prior art". This is clearly not a proper basis for an indefiniteness rejection.

It is well settled that the breadth of claim has no bearing on the definiteness of a claim. "Breadth is not indefiniteness." In re Gardner, 427 F.2d 786 (1970); In re Miller, 441 F.2d 689, 693 (CCPA 1971) ("breadth is not to be equated with indefiniteness, as we have said many times"); In re Robins, 429 F.2d 452, 458 (CCPA 1970).

#### Proper Standard for Definiteness

The definiteness inquiry focuses on whether those skilled in the art would understand the scope of the claim when the claim is read in light of the rest of the specification. Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1576 (Fed. Cir. 1986).

We have reviewed all claims in light of the specification, and believe that all claims satisfy the definiteness standard. When construed in light of the specification, the scope of each pending claim would be understood by one of ordinary skill in the art.

Accordingly, no *prima facie* showing of indefiniteness has been presented.

#### Clarification

If the rejection is maintained, we request that indefinite terms, phrases of grammatical constructions be indicated so that specific concerns regarding the scope of the claim may be addressed.

**Conclusion**

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

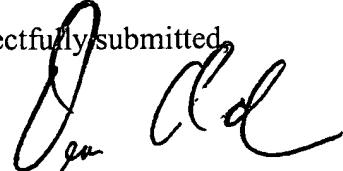
Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Dean Alderucci at telephone number 203-461-7337 or via electronic mail at Alderucci@WalkerDigital.com.

**Petition for Extension of Time to Respond**

Applicants hereby petition for a **three-month** extension of time with which to respond to the Office Action. Please charge \$475.00 for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an extension of time is required, or if an additional extension of time is required in addition to that requested in a petition for an extension of time, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,



February 18, 2004

---

Dean Alderucci  
Attorney for Applicants  
Registration No. 40,484  
Alderucci@WalkerDigital.com  
203-461-7337 / voice  
203-461-7300 / fax